

U.S. PATENT & TRADEMARK OFFICE  
MAY 14 2001

MILBANK, TWEED, HADLEY & MCCLOY LLP

SERIAL NO. 09/474,677  
ATTORNEY DOCKET NO. 36325-00600

UPT-1644\$  
#3  
Harvey  
May 18, 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Yash P. Sharma  
Serial No.: 09/474,677  
Filed: December 9, 1999  
Title: TREATMENT AND PREVENTION OF HIV AND OTHER VIRAL INFECTIONS

Art Unit: 1644  
Examiner: M. Tung  
Attorney Docket No. 36325-00600

TRANSMITTAL LETTER

RECEIVED

MAY 15 2001

TECH CENTER 1600/2900

Assistant Commissioner for Trademarks  
Washington, DC 2202-3513

Sir:

Transmitted herewith are the following documents:

1. Election with Traverse and Request for Reconsideration
2. Check No. 3229 for \$195.00.

If there are any charges, or any credits, please apply them to Deposit Account No. 13-3250.

Respectfully submitted,

Date: May 7, 2001

Michael H. Jacobs  
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Date of Deposit: May 7, 2001  
I hereby certify under 37 C.F.R. § 1.8 that this correspondence is being deposited with the United States Postal Service on the date indicated above with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, DC 20231.

Karen L. Hudson  
Karen L. Hudson



MILBANK, TWEED, HADLEY & CLOY LLP

SERIAL NO. 09/474,677  
Docket No. 36325-00600

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

Applicant : Yash P. Sharma

Art Unit : 1644

MAY 15 2001

Serial No. : 09/474,677

Examiner : M. Tung

Filed : December 29, 1999

TECH CENTER 1600/2900

Title : TREATMENT AND PREVENTION OF HIV AND OTHER VIRAL  
INFECTIONS

Assistant Commissioner for Patents  
Washington, D.C. 20231

RECEIVED SERIAL NO. 09/474,677  
MAY 15 2001

135.00 CP

#4  
Harry  
May 18, 2001

ELECTION WITH TRAVERSE AND REQUEST FOR RECONSIDERATION

Sir:

In response to the restriction requirement mailed February 5, 2001, the period for response to which expires on May 7, 2001, given the requested two-month extension of time and that May 5 and 6, 2001, fall on Saturday and Sunday, respectively, please consider the following.

The Examiner made a restriction requirement between Group I (claims 1-27) and Group II (claims 28-31). Applicant provisionally elects Group I (claims 1-27), further provisionally elects the specific condition viral infection, and still further provisionally elects retrovirus on which claims 1-3 and 6-20 read. Applicant respectfully traverses this restriction requirement and the species restrictions made by the Examiner.

The restriction requirement is improper because the Examiner has not shown that examining the entire subject matter of the claims would constitute a serious burden. M.P.E.P. § 803 provides:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus for a restriction requirement to be valid, the Examiner must establish the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) the search and examination of the entire application cannot be made without serious burden (M.P.E.P. § 803).

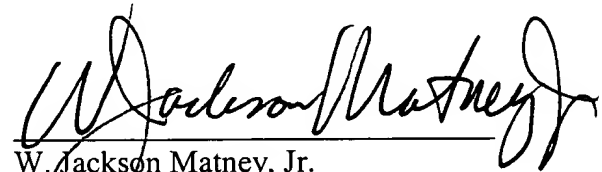
The Examiner has not established that the second requirement has been met. A search of the subject matter of Group I, drawn to a "method for preventing or treating a disease or infection," would necessarily include the subject matter of Group II, drawn to a "method for

treating a blood product.” Thus, it is urged that it would not be a serious burden on the Examiner to examine Groups I and II together. Moreover, no burden was expressed in the Office Action associated with the search and examination of the species-restricted subject matter referred to as “viral infection,” “immune-mediated disease,” “pathogenic infection,” “retrovirus,” “hepatitis virus,” “herpes virus,” “bacterial infection,” “parasite,” “influenza,” and “malaria.” For example, enveloped viruses are defined as including “retro viruses,” “hepatitis viruses,” and “herpes viruses” and, as such, the burden on the Patent Office is eased. See Robert F. Boyd, Ph.D and Bryan G. Hoert, Ph.D, Basic Medical Microbiology, Fourth edition, 1991, p. 615-657. It is believed that the Office Action is silent on this issue because such a burden is not a “serious” one, as is required by the M.P.E.P. Additionally, withdrawal of the restriction requirement is also respectfully requested due to the fact that the applicant is an individual.

In view of the above remarks, Applicant respectfully requests reconsideration and withdrawal or modification of the restriction requirement.

Please charge any additional fees, or make any credits, to Deposit Account No. 13-3250, reference No. 36325-00600.

Respectfully submitted,

  
W. Jackson Matney, Jr.  
Reg. No. 39,292

Date: May 4, 2001

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Karen L. Hudson  
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